



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,854	06/18/2001	Gilad Odinak	WING-1-1016	1886

25315 7590 06/14/2005

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,854

Applicant(s)

ODINAK ET AL.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 19-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 19-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Amendment, received on 3/7/2005, is acknowledged and entered. The applicant has amended claims 1, 10, 19, 26, 27, 36, 37, 43, 44, 47, 48, 49. Claims 1-10 and 19-54 are withdrawn without traverse. Currently claims 1-10 and 19-54 are pending for examination.

Response to Arguments

2.1. Applicant's arguments filed concerning rejection of claims 1-7, 9-10, 19-23, 25-33, 35-40, 42-51, and 33-34 on 3/7/2005 have been fully considered but are moot in view of the new ground(s) of rejection.

2.2. The applicant argues, see remarks, pages 22-23 that the prior art of Treyz cannot be combined with the prior art of Crosby because Treyz does not expressly or inherently teach or suggest tailoring information provided to the user based upon local radio station broadcasts and therefore the examiner has used hindsight to combine Crosby and Treyz. The examiner respectfully disagrees. Contacting banking system and business system and implementing of transfer of money, as recited in claims 8-9 is required to complete a purchase transaction being executed from the vehicle and both Crosby (Now Crosby in view of Newell, the new grounds of rejection used in present office action) and Treyz teach sending purchasing requests from the vehicle but Crosby does not disclose completing the purchasing transaction by contacting a bank and implementing a transfer of money, whereas Treyz does. Therefore, it would be obvious to one of an ordinary skill in the art to combine the teachings of Treyz with those of Crosby (Now Crosby in view of Newell, the new grounds of rejection used in present office action) to complete the purchase transaction by contacting the bank and implementing the

Art Unit: 3625

transfer of money. In response to applicant's argument, prior art of Treyz cannot be combined with Crosby, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As analyzed above, it would be obvious to one of an ordinary skill in the art to combine the teachings of Treyz with those of Crosby (Now Crosby in view of Newell, the new grounds of rejection used in present office action) to complete the purchase transaction by contacting the bank and implementing the transfer of money.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Both Crosby/Newell and Treyz combined together disclose the teachings of the claimed invention and as analyzed above it would be obvious to one of an ordinary skill in the art to combine the teachings of Treyz with those of Crosby (Now Crosby in view of Newell, the new grounds of rejection used in present office action) to complete the purchase transaction by contacting the bank and implementing the transfer of money.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Crosby/Newell and Treyz combined together disclose the teachings of the claimed invention and as analyzed above it would be obvious to one of an ordinary skill in the art to combine the teachings of Treyz with those of Crosby (Now Crosby in view of Newell, the new grounds of rejection used in present office action) to complete the purchase transaction by contacting the bank and implementing the transfer of money.

In response to applicant's argument that prior art of Treyz is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, prior art of Treyz is reasonably pertinent to the particular problem with which the applicant was concerned, that is completing the purchase transaction by contacting the banking system and implementing the money transfer while making purchases from a mobile device mounted in a vehicle.

3. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-9, 24, 25 and 33-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-9 recites the limitation "wherein completing comprises" in claim 8. There is insufficient antecedent basis for this limitation in the claim 1 on which they are dependent.

Claims 24 and 25 are also rejected for similar reasons.

Claims 33 and 34 recite the limitations "a voice recognition..." and "a monetary transfer component ..." respectively. There is insufficient antecedent basis for these limitations in the claim 27 on which they are dependent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 5.1. Claims 1-7, 9-10, 19-23, 25-33, 35-40, 42-51, and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crosby, and further in view of Newell et al.(US Patent 6,895,238), hereinafter, referred to Newell.

Regarding claims 1-7 and 9-10, Crosby teaches a method comprising:

Art Unit: 3625

receiving a radio broadcast at a vehicle, the vehicle having vehicle information; wirelessly transmitting content associated with the vehicle information from a server to the vehicle via a data network based on radio broadcast information associated with the received radio broadcast, automatically presenting a content over a user interface; processing each sent request wherein processing comprises generating a confirmation message upon completing a transaction based on the request; wirelessly transmitting the generated confirmation message over the data network; and presenting the sent confirmation message over the user interface, further comprising wirelessly transmitting vehicle information- identifying vehicle location and direction of travel- from the vehicle to the server over the data network, wherein the content transmitted from the server to the user via a data network is based on radio broadcast information associated with the vehicle information includes at least one of the vehicle's location, trajectory, information requests, or transaction requests, wherein completing comprises: contacting a business system; and sending information from the business system to the server relating to the request, wherein the confirmation information comprises at least a portion of the information sent by the business system, and wherein the request is a request to purchase an item offered for purchase in one or more of the received radio broadcast or the sent content (see at least col.5, line 66-col.8, line 47, Quote:

" *FIG. 1 illustrates an interactive radio network 100 wherein signals broadcast by land-based radio broadcasters 102 are received by interactive radio mobile units or mobile stations mounted within vehicles 104, with each mobile unit operated by a subscriber or other user (not separately shown.) While listening to a radio broadcast, the subscribers transmit commands or other responsive signals from the mobile units via a communications satellite 106 to an interactive radio network ground station 108, which forwards the commands to an interactive radio network operations center 110. In response to commands received from the subscribers, the network operations center provides information feedback*

Art Unit: 3625

to the subscribers via the Internet 111, with the information being received at individual subscriber computers 112. In this manner, subscribers operating mobile units mounted within automobiles, trucks, planes, trains or the like, may request information pertaining to program segments broadcast by the various broadcasters..... ..The subscriber thereby obtains information such as the song name and performer name for various musical selections of interest and, if desired, purchases any or all of the songs via e-commerce Internet sites accessible via the computer.In one other application, the system is configured to permit a subscriber to immediately enter a purchase order via the mobile unit, then review confirmation information via the Internet. Each mobile unit includes a broadcast radio receiver and a wireless transmitter.The wireless transmitter is a satellite wireless communications device, which transmits signals via satellite 106 to interactive radio ground station 108. (Herein-below, alternative implementations utilizing cellular telephone base stations or dedicated localized communication systems are described.)The primary components of the mobile unit are illustrated in FIG. 2 and include a radio receiver 116, a GPS unit 118, a wireless satellite telephone transmitter 120 and a subscriber interface 122 for receiving control signals from an subscriber via one or more input buttons or other input devices..... The subscriber interface receives GPS coordinates from the GPS unit and receives radio broadcast signals from the radio receiver then, in response to commands entered by the subscriber, generates various interactive radio signals for transference to the wireless transmitter for transmission to the network operations center of FIG. 1. Referring again to FIG. 1, network operations center 110 processes the interactive radio signals transmitted by the mobile unit and generate appropriate feedback to the subscriber via the Internet..... Next, the network operations center downloads information pertinent to the program segment and provides that information within a web site accessible by the subscriber, Thereafter, the subscriber may download the information from the web site into his or her computer or PDA by accessing the web site using the subscriber name and password. Alternatively, In the example wherein the program segment selected by the subscriber is a musical selection, the network operations center provides information including the song title, CD title, In the example wherein the radio program segment selected by the subscriber is a radio advertisement, the network operations center provides information within a web

page identifying the vendor and the specific goods or services offered for sale within the advertisement.

.... ". Unquote. See also col.col.4, lines 42-45 and col.11, line 1-col.12, line 11.).

Crosby does not disclose automatically presenting the content over a user interface at the vehicle and recording any requests made by a user based on the presented content wirelessly transmitting the recorded requests to the server over the data network

(Crosby teaches automatically presenting the content over a user interface, that is a computer, PDA, etc via Internet to the user's home or work). However, in the same field of endeavor, that is for providing entertainment to a portable device in a vehicle (see title), generating revenue or providing advertisement opportunities based on the location and status of the vehicle (col.1, lines 36-38), sending requests for purchases, advertisement requests (col.4, lines 16-19) suggests automatically presenting the content over a user interface at the vehicle instead at the user's home or work computer/PDA (see at least col.2, lines 65-col.4, line 67 discloses that a multimedia device 20, including a computer 50, LCD display screen 160, a microphone input 176, etc, is mounted in the vehicle receiving broadcasts from Radio/TV broadcasting stations and e-mails and alerts including interactive interface) and also recording the user's requests by microphone (the applicant's disclosure also uses microphone to record the user's request. Crosby , as analyzed above discloses allowing the user to place order from the vehicle as well as from the work or hoe computers but does not disclose recording the purchase request via a microphone. Newell's art discloses using a microphone to record the purchase requests via microphone, see col.4, lines 16-18 and lines 59-67).

In view of Newell, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Crosby to incorporate Newell's multimedia device 20 in the vehicle because, as explicitly disclosed in Newell, it would allow the system to provide facilities for receiving multimedia content in the vehicle itself allowing users to send

purchase requests in response to advertisements transmitted, play games, receive personal information such as e-mails or alerts or navigational data.

Regarding claims 4-7, Newell teaches that presenting comprises at least a portion of the content or the message audibly, or displaying visually at least a portion of the content or the message, recording comprises recording a phonation and processing request comprises performing voice recognition processing of the phonation, see Newell at least col.4, lines 15-67, which discloses a LCD with display screen used for displaying the content in the vehicle, a microphone for recording a phonation, speakers "152" see Fig.2 for presenting content audibly and "Keyword recognition software" perform voice recognition processing of the phonation. In view of Newell, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Crosby to incorporate Newell's features of presenting a portion of the content or the message audibly, or displaying visually at least a portion of the content or the message, recording comprises recording a phonation and processing request comprises performing voice recognition processing of the phonation in the multimedia device 20 in the vehicle, as explicitly disclosed in Newell, because it would allow the system to provide convenience of receiving multimedia content in the vehicle on a display screen or audibly and recording and transmitting verbal purchase requests.

Regarding system and apparatus claims, 19-23, 25-33, 35-40, 42-51, and 53-54, their limitations correspond to the limitations of method claims 1-7, and 9-10 and are therefore analyzed and rejected based on the same rationale.

5.2. Claims 8, 24, 34, 41, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crosby in view of Newell, and further in view of Treyz et al. (US Patent 6,526,335 B1), hereinafter, referred to as Treyz.

With regards to claims 8, 24, 34, 41, and 52, Crosby teaches a method, a system, and an apparatus, as disclosed in claims 1, 19, 27, 37, and 49 respectively and analyzed above. From the above analysis based on Crosby it is evident that the user in the vehicle is able to purchase products based upon the broadcast content. Crosby does not show, contacting a bank system to execute a monetary transfer based on user information and the request. However, in the field of same endeavor, that is using an interactive automobile personal computer system in a vehicle, Treyz teaches contacting a bank and executing a money transfer based on user information and request via a communication network (see at least, Figs 50 and 51 and col.45, line 9-col.46, line 6, " *At step 646, automobile personal computer 14 may communicate with the wireless device to authorize payment on behalf of the user. The payment may be for any suitable benefit, such as purchasing a product or service such as food Audible and visual techniques may be used to convey this information and to confirm that the transaction took place. ... Financial transactions may be involved in using automobile personal computer 14 to interact with wireless communications devices over remote and local wireless links. " and col.71, lines 28-42, " Steps 1002 and 1004 may be implemented locally on automobile personal computer 14, may be implemented remotely (e.g., on a remote server that is in communication with automobile personal computer 14 over a remote wireless link such as a remote wireless Internet link or the like), A benefit may be provided remotely by crediting the user's bank account " .*

In view of Treyz, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine Treyz's feature of contacting a bank and executing a money transfer based on user information and request via a communication network with Crosby's

Art Unit: 3625

interactive radio service system in a vehicle, because to allow the passengers in the vehicle to communicate with any other server including that of a bank and execute money transfer to close a purchase deal.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,779,196 to Igbinadolor (see at least Abstract) discloses a computerized integrated multimedia vehicle device receiving radio/TV broadcasts for playing/recording these broadcasts, supports internet access, on-line banking system, stock market trading, microphone and camera provides telephone/video conferencing, recording, receiving content in both audio/video format and can be used with Crosby to render the claimed invention obvious.

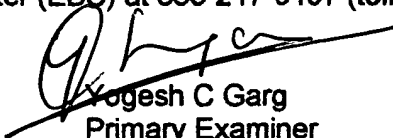
US Publication: 2005/0028208 to Ellis et al. discloses interactive television program guide with remote access (see Abstract at least).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
June 11, 2005